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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,093	08/31/2001	Michael Ganser	016790-0437	7674

22428 7590 08/04/2003

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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LEARY, LOUISE N

ART UNIT	PAPER NUMBER
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1654

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DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/943,093

Applicant(s)

GANSER ET AL.

Examiner

Louise N. Leary

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-15 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 16-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 1-39 are pending in this application.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 16-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Liotta et al (US 5,843,657).

Liotta et al disclose a method for laser beam microdissection of single or multiple regions in a sample specimen. See the abstract, column 17, lines 1-41 and column 18, lines 1-39. Liotta et al disclose "...discontinuous regions of interest could be selected and procured by appropriate aiming and application of the electromagnetic energy", i.e. a laser beam. Note the abstract and column 13, lines 1-17. With respect to the specimen holder, Liotta et al disclose contacting the sample with a transfer surface before cutting the sample with a laser. Note column 12, lines 62-68 and column 13 lines 1-39. Regarding the size of the sample, Liotta et al disclose that after the transfer surface is brought into contact with the cellular material sample the region of interest can range in size to an area smaller than a single cell (< 10 microns), to a few cells, to a whole field of cells or tissue. Liotta et al disclose "...a single transfer surface can be

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used to remove a plurality of areas of interest from a single cellular material sample".

Note column 13, lines 27-29. Additionally, regarding forming and severing the web as described in the instant claims, Liotta et al disclose "alternatively, one or more of the procured cellular material regions can be removed from the transfer surface 30, or portions of the transfer surface 30 to which the procured cellular material are adhered can be punched out of the transfer surface 30 and analyzed separately." Note lines 34-39. With respect to the apparatus described in the instant claims, Liotta et al disclose an apparatus comprising a microscope and controls for cutting the tissue sample using laser energy. Note figures 1-8 and column 3, lines 35-68. Liotta et al also address the "computer readable medium" described in the instant claims because Liotta et al disclose the use of an automated sample analyzer. See column 6, lines 2-8. Thus, Liotta et al disclose the invention claimed except for using the word "web".

However, the respect to the meaning of the word "web" as used in the instant claims, Liotta et al disclose a method for microdissection of one or more regions of a sample of interest using a laser beam which inherently forms a ---web--- in the sample.

Hence, Liotta et al disclose all the instant claim limitations except for using the word "web" to describe a sample after cutting with a laser but Liotta et al inherently disclose forming a web in an area of sample tissue of interest using a laser beam apparatus and microdissection method which anticipates or renders obvious the claimed invention.

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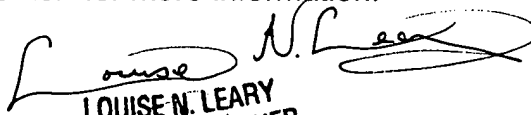
Therefore, the burden of proof is on applicants to show patentably distinct differences between the Liotta et al disclosure and the methods and apparatus claimed in the present invention.

3. Claims 6-15 are allowable over the prior art of record.
4. The Schutze et al reference (US 5,998,129) and the Baer et al reference (US 6,469,779) have been cited to further show the state of this reference.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louise N. Leary whose telephone number is (703) 308-3533. The examiner can normally be reached on Monday to Friday from 9:30 to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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LOUISE N. LEARY  
PRIMARY EXAMINER

August 2, 2003